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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,499	04/06/2005	Daniel Page	100831-1P US	6678

22466 7590 09/21/2007  
ASTRA ZENECA PHARMACEUTICALS LP  
GLOBAL INTELLECTUAL PROPERTY  
1800 CONCORD PIKE  
WILMINGTON, DE 19850-5437

EXAMINER
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RAHMANI, NILOOFAR

ART UNIT	PAPER NUMBER
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1625

MAIL DATE	DELIVERY MODE
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09/21/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/530,499	PAGE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Niloofer Rahmani	1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 15-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 15-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☒ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 1-10, 15-24 are currently pending in the instant application and claims 11-14 are cancelled.

#### *Priority*

2. This application is filed on 04/06/2005, which is a 371 of PCT/SE03/01604, filed on 10/15/2003, which claims priority of SWEDEN 0203070-8, filed on 10/16/2002.

The claimed benefit of priority date is denied. There is no priority document on the file. The filing date of the instant application is 10/15/2003.

#### **3. *Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10, 15-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-10, 15-24 are rejected because the term "electron-withdrawing groups" is confusing. The "electron-withdrawing groups" can be started from halogen groups, CN, NO<sub>2</sub>, etc. Correction is required.

4. Claims 1-10, 15-24 are rejected because the term "C<sub>1-10</sub> divalent group that separates groups connected thereto by one or two atoms" in the definition for X is confusing. What is the term "C<sub>1-10</sub> divalent group that separates groups connected thereto by one or two atoms" means? Correction is required.

5. Claims 1-10, 15-24 are rejected because the term "C<sub>4-12</sub> divalent aromatic group" in the definition for Ar is confusing. What is the term "C<sub>4-12</sub> divalent aromatic group" means? Correction is required.

6. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "producing a compound" is confusing. There is no reaction step to produce a compound by reacting a compound of formula (II) with R<sup>2</sup>OArXCOA. Correction is required.

7. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "producing a compound" is confusing. There is no reaction step to produce a compound by reacting a compound of formula (III) with formaldehyde. Correction is required.

8. ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 16, and 22-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is “undue”. These factors include 1) the breadth of the claims, 2) the nature of the invention, 3) the state of the prior art, 4) the level of one of ordinary skill, 5) the level of predictability in the art, 6) the amount of direction provided by the inventor, 7) the existence of working examples, and 8) the quantity of experimentation needed to make or use the invention based on the content of the disclosure. In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

- 1) The breadth of the claims.
- 2) The nature of the invention,
- 3) The state of the prior art,
- 4) The level of one of ordinary skill,
- 5) The level of predictability in the art,
- 6) The amount of direction provided by the inventor,
- 7) The existence of working examples,
- 8) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

**The nature of the invention:** The instant invention is drawn to a method for the therapy of pain in a warm-blooded animal, using the compound of claims 1 or 8 or 9 or 10.

**The state of the prior art:** “ The endocannabinoid system exerts an important neuromodulatory role in mammals. Knockout mice lacking cannabinoid (CB) receptors exhibit significant morbidity. The genes encoding CB receptors and FAAH appear to have been lost in insects, or their protein sequences mutated

into unrecognizable pseudogenes. The lack of a functional endocannabinoid system in insects is quite remarkable, because the system appears to be physiologically important in mammals, and the system exists in animals phylogenetically older than insects.”( Mcpartland et al., The Journal of Comparative neurology, Vol. 436, pages 423-429).

**The predictability in the art:** It is noted that the pharmaceutical art is unpredictable, requiring each embodiment to be individually assessed for physiological activity. *In re Fisher*, 427 F. 2d 833, 166 USPQ 18 (CCPA 1970) indicates that the more unpredictable an area is, the more specific enablement is necessary in order to satisfy the statute. In the instant case, the instantly claimed invention is highly unpredictable since one skilled in the art would recognize that in regards to the therapeutic effects, whether or not the compounds of formula of claim 1 would be useful for treating a pharmacological condition in a subject.

**Amount of guidance/working examples:** On pages 24-32 and Table 1 of the specification, applicant has examples of test compounds for assay of hCB1 and hCB2 activity. However, applicant has not guidance or examples for the therapy of pain in a warm-blooded animal.

**The breadth of the claims:** The breadth of claims is drawn to a method for the therapy of pain in a warm-blooded animal, using the compound of claims 1 or 8 or 9 or 10.

**The quantity of undue experimentation needed:** Since the guidance and teaching provided by the specification is insufficient for therapy of pain in a warm-

Art Unit: 1625

blooded animal, using the compound of claims 1 or 8 or 9 or 10, one of ordinary skill in the art, even with high level of skill, is unable to use the instant compounds as claimed without undue experimentation.

**The level of the skill in the art:** The level of skill in the art is high. However, due to the unpredictability in the pharmaceutical art, it is noted that each embodiment of the invention is required to be individually assessed for physiological activity by in vitro and in vivo screening to determine which compounds exhibit the desired pharmacological activity and which diseases would benefit from this activity.

Taking all of the above into consideration, it is not seen where the instant claims 16, and 22-24, for therapy of pain in a warm-blooded animal, using the compound of claims 1 or 8 or 9 or 10, have been enabled by the instant specification.

**9. Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

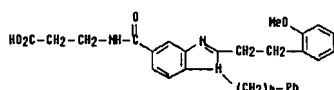
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 5-6, 15, and 19-21 are rejected under 35 U.S.C. 102(a) as being anticipated by Lau et al., WO 03/053938. Lau et al. disclosed the instant claimed compounds, which from the STN is

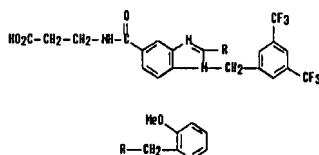
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**CN** b-Alanine, N-[[2-[2-(2-methoxyphenyl)ethyl]-1-(4-phenylbutyl)-1H-benzimidazol-5-yl]carbonyl]



**RN** 552839-53-9

**CN** b-Alanine, N-[[1-[[[3,5-bis(trifluoromethyl)phenyl]methyl]-2-[(2-methoxyphenyl)methyl]-1H-benzimidazol-5-yl]carbonyl]



. Therefore, the instant claim is anticipated by Lau et al.

**10.** Claims 1, and 15 are rejected under 35 U.S.C. 102(a,e) as being anticipated by Cheng et al., WO 2002085866. Cheng et al. disclosed the instant claimed compounds, which from the STN is

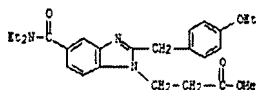
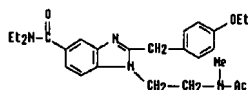
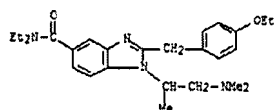
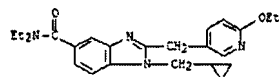
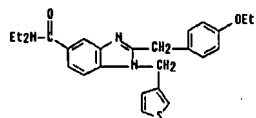
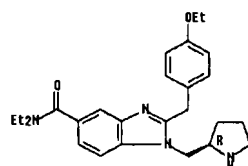
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**CN** 1H-Benzimidazole-1-propanoic acid, 5-[(diethylamino)carbonyl]-2-[(4-

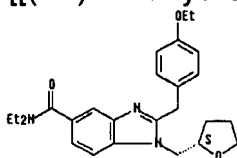
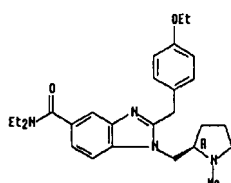
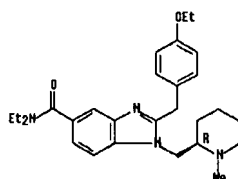
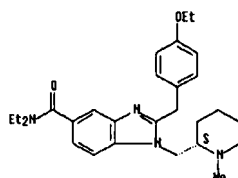
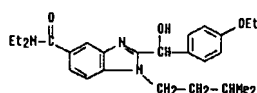


Art Unit: 1625

ethoxyphenyl)methyl]-, methyl ester, trifluoroacetate

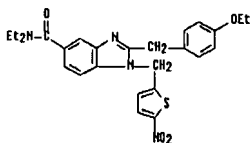
**RN** 474015-20-8**CN** 1H-Benzimidazole-5-carboxamide, 1-[2-(acetylmethylamino)ethyl]-2-[(4-ethoxyphenyl)methyl]-N,N-diethyl-, mono(trifluoroacetate)**RN** 474015-39-9**CN** 1H-Benzimidazole-5-carboxamide, 1-[2-(dimethylamino)-1-methylethyl]-2-[(4-ethoxyphenyl)methyl]-N,N-diethyl-, trifluoroacetate**RN** 474015-48-0**CN** 1H-Benzimidazole-5-carboxamide, 1-(cyclopropylmethyl)-2-[(6-ethoxy-3-pyridinyl)methyl]-N,N-diethyl**RN** 474016-36-9**CN** 1H-Benzimidazole-5-carboxamide, 2-[(4-ethoxyphenyl)methyl]-N,N-diethyl-1-(3-thienylmethyl)-, trifluoroacetate**RN** 474016-41-6**CN** 1H-Benzimidazole-5-carboxamide, 2-[(4-ethoxyphenyl)methyl]-N,N-diethyl-1-[(2R)-2-pyrrolidinylmethyl]-, trifluoroacetate

Art Unit: 1625

**RN** 474016-46-1**CN** 1H-Benzimidazole-5-carboxamide, 2-[(4-ethoxyphenyl)methyl]-N,N-diethyl-1-[[[(2S)-tetrahydro-2-furanyl]methyl]-, trifluoroacetate**RN** 474016-51-8**CN** 1H-Benzimidazole-5-carboxamide, 2-[(4-ethoxyphenyl)methyl]-N,N-diethyl-1- [[[(2R)-1-methyl-2-pyrrolidiny]methyl]-, trifluoroacetate**RN** 474016-56-3**CN** 1H-Benzimidazole-5-carboxamide, 2-[(4-ethoxyphenyl)methyl]-N,N-diethyl-1- [[[(2R)-1-methyl-2-piperidiny]methyl]-, trifluoroacetate**RN** 474016-61-0**CN** 1H-Benzimidazole-5-carboxamide, 2-[(4-ethoxyphenyl)methyl]-N,N-diethyl-1-[[[(2S)-1-methyl-2-piperidiny]methyl]-, trifluoroacetate**RN** 474016-67-6**CN** 1H-Benzimidazole-5-carboxamide, 2-[(4-ethoxyphenyl)hydroxymethyl]-N,N-diethyl-1-(3-methylbutyl)-, trifluoroacetate**RN** 474017-17-9

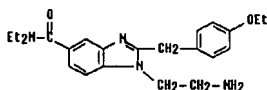
Art Unit: 1625

**CN** 1H-Benzimidazole-5-carboxamide, 2-[(4-ethoxyphenyl)methyl]-N,N-diethyl-1-[(5-nitro-2-thienyl)methyl]-



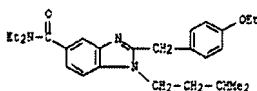
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**CN** 1H-Benzimidazole-5-carboxamide, 1-(2-aminoethyl)-2-[(4-ethoxyphenyl)methyl]-N,N-diethyl-, trifluoroacetate



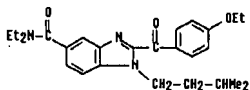
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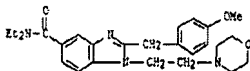
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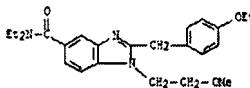
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**RN** 474014-98-7

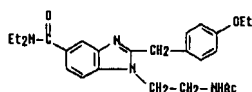
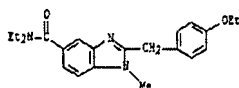
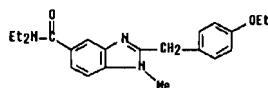
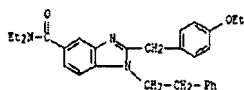
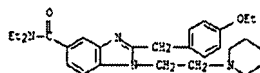
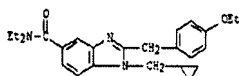
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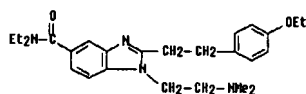
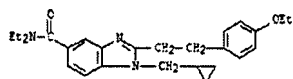
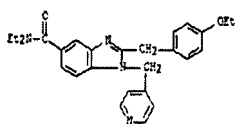
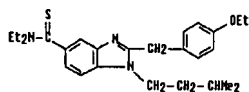
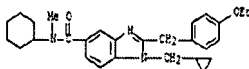
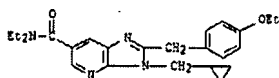
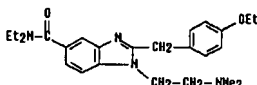
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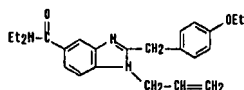
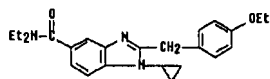
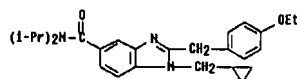
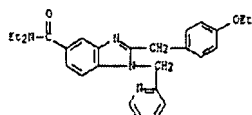
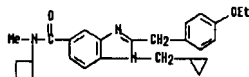
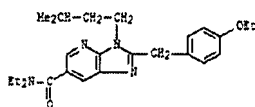
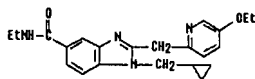
Art Unit: 1625

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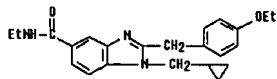
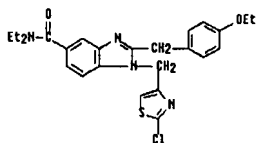
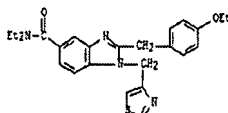
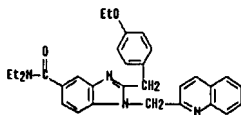
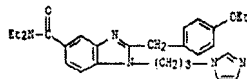
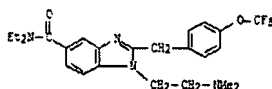
Art Unit: 1625

**RN** 474015-56-0**CN** 1H-Benzimidazole-5-carboxamide, 1-(cyclopropylmethyl)-2-[2-(4-ethoxyphenyl)ethyl]-N,N-diethyl**RN** 474015-66-2**CN** 1H-Benzimidazole-5-carboxamide, 2-[(4-ethoxyphenyl)methyl]-N,N-diethyl-1-(4-pyridinylmethyl)-, trifluoroacetate**RN** 474015-71-9**CN** 1H-Benzimidazole-5-carboxamide, 2-[(4-ethoxyphenyl)methyl]-N,N-diethyl-1-(3-methylbutyl)**RN** 474015-73-1**CN** 1H-Benzimidazole-5-carboxamide, N-cyclohexyl-1-(cyclopropylmethyl)-2-[(4-ethoxyphenyl)methyl]-N-methyl-, hydrochloride**RN** 474016-14-3**CN** 3H-Imidazo[4,5-b]pyridine-6-carboxamide, 3-(cyclopropylmethyl)-2-[(4-ethoxyphenyl)methyl]-N,N-diethyl**RN** 474017-37-3**CN** 1H-Benzimidazole-5-carboxamide, 1-[2-(dimethylamino)ethyl]-2-[(4-ethoxyphenyl)methyl]-N,N-diethyl

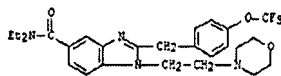
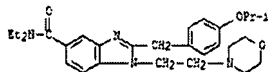
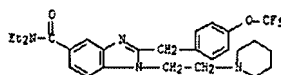
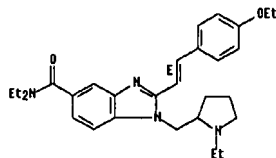
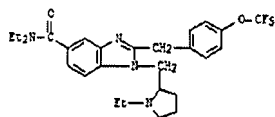
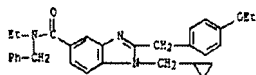
Art Unit: 1625

**RN 474017-41-9****CN** 1H-Benzimidazole-5-carboxamide, 2-[(4-ethoxyphenyl)methyl]-N,N-diethyl-1-(2-propenyl)**RN 474017-45-3****CN** 1H-Benzimidazole-5-carboxamide, 1-cyclopropyl-2-[(4-ethoxyphenyl)methyl]-N,N-diethyl**RN 474017-49-7****CN** 1H-Benzimidazole-5-carboxamide, 1-(cyclopropylmethyl)-2-[(4-ethoxyphenyl)methyl]-N,N-bis(1-methylethyl)**RN 474017-52-2****CN** 1H-Benzimidazole-5-carboxamide, 2-[(4-ethoxyphenyl)methyl]-N,N-diethyl-1-(2-pyridinylmethyl)**RN 474017-58-8****CN** 1H-Benzimidazole-5-carboxamide, N-cyclobutyl-1-(cyclopropylmethyl)-2-[(4-ethoxyphenyl)methyl]-N-methyl**RN 474017-65-7****CN** 3H-Imidazo[4,5-b]pyridine-6-carboxamide, 2-[(4-ethoxyphenyl)methyl]-N,N-diethyl-3-(3-methylbutyl)**RN 474017-86-2****CN** 1H-Benzimidazole-5-carboxamide, 1-(cyclopropylmethyl)-2-[(5-ethoxy-2-pyridinyl)methyl]-N-ethyl

Art Unit: 1625

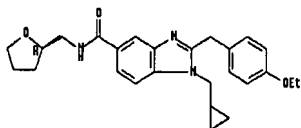
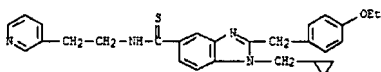
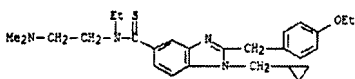
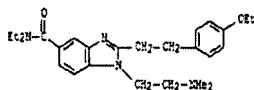
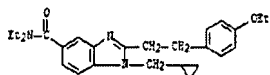
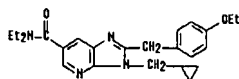
**RN** 474017-92-0**CN** 1H-Benzimidazole-5-carboxamide, 1-(cyclopropylmethyl)-2-[(4-ethoxyphenyl)methyl]-N-ethyl**RN** 474017-99-7**CN** 1H-Benzimidazole-5-carboxamide, 1-[(2-chloro-4-thiazolyl)methyl]-2-[(4-ethoxyphenyl)methyl]-N,N-diethyl-**RN** 474018-02-5**CN** 1H-Benzimidazole-5-carboxamide, 2-[(4-ethoxyphenyl)methyl]-N,N-diethyl-1-(4-thiazolylmethyl)**RN** 474018-06-9**CN** 1H-Benzimidazole-5-carboxamide, 2-[(4-ethoxyphenyl)methyl]-N,N-diethyl-1-(2-quinolinylmethyl)**RN** 474018-09-2**CN** 1H-Benzimidazole-5-carboxamide, 2-[(4-ethoxyphenyl)methyl]-N,N-diethyl-1-[3-(1H-imidazol-1-yl)propyl]**RN** 474018-13-8**CN** 1H-Benzimidazole-5-carboxamide, 1-[2-(dimethylamino)ethyl]-N,N-diethyl-2-[[4-(trifluoromethoxy)phenyl]methyl]**RN** 474018-15-0**CN** 1H-Benzimidazole-5-carboxamide, N,N-diethyl-1-[2-(4-morpholinyl)ethyl]-2-[[4-(trifluoromethoxy)phenyl]methyl]

Art Unit: 1625

**RN** 474018-19-4**CN** 1H-Benzimidazole-5-carboxamide, N,N-diethyl-2-[[4-(1-methylethoxy)phenyl]methyl]-1-[2-(4-morpholinyl)ethyl]**RN** 474018-22-9**CN** 1H-Benzimidazole-5-carboxamide, N,N-diethyl-1-[2-(1-piperidiny)ethyl]-2-[[4-(trifluoromethoxy)phenyl]methyl]**RN** 474018-24-1**CN** 1H-Benzimidazole-5-carboxamide, 2-[(1E)-2-(4-ethoxyphenyl)ethenyl]-N,N-diethyl-1-[(1-ethyl-2-pyrrolidiny)methyl]**RN** 474018-27-4**CN** 1H-Benzimidazole-5-carboxamide, N,N-diethyl-1-[(1-ethyl-2-pyrrolidiny)methyl]-2-[[4-(trifluoromethoxy)phenyl]methyl]**RN** 474018-31-0**CN** 1H-Benzimidazole-5-carboxamide, 1-(cyclopropylmethyl)-2-[[4-(ethoxyphenyl)methyl]-N-ethyl-N-(phenylmethyl)]**RN** 474018-34-3**CN** 1H-Benzimidazole-5-carboxamide, 1-(cyclopropylmethyl)-2-[[4-(ethoxyphenyl)methyl]-N-[(2R)-tetrahydro-2-furanyl]methyl]



Art Unit: 1625

**RN** 474018-66-1**CN** 1H-Benzimidazole-5-carbothioamide, 1-(cyclopropylmethyl)-2-[(4-ethoxyphenyl)methyl]-N-[2-(3-pyridinyl)ethyl]**RN** 474018-69-4**CN** 1H-Benzimidazole-5-carbothioamide, 1-(cyclopropylmethyl)-N-[2-(dimethylamino)ethyl]-2-[(4-ethoxyphenyl)methyl]-N-ethyl**RN** 474019-56-2**CN** 1H-Benzimidazole-5-carboxamide, 1-[2-(dimethylamino)ethyl]-2-[2-(4-ethoxyphenyl)ethyl]-N,N-diethyl-, hydrochloride**RN** 474019-59-5**CN** 1H-Benzimidazole-5-carboxamide, 1-(cyclopropylmethyl)-2-[2-(4-ethoxyphenyl)ethyl]-N,N-diethyl-, monohydrochloride**RN** 474020-70-7**CN** 3H-Imidazo[4,5-b]pyridine-6-carboxamide, 3-(cyclopropylmethyl)-2-[(4-ethoxyphenyl)methyl]-N,N-diethyl-, monohydrochloride

Therefore, the instant claim is anticipated by Cheng et al.

## 11. Claim Rejections - Obvious Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 168 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130 (b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10, 15-16, and 19-21 are provisionally rejected under the judicially created doctrine obviousness-type double patenting as being unpatentable over claims 1-6 of the US 7,030,139. Although the conflicting claims are not identical, they are not patentably distinct from each other because the current invention embraces the invention claimed in the above conflicting application based on the ground of the overlapping relationship.

Determination of the scope and content of the prior art (MPEP §2141.01)

Claims 1-6 of the US 7,030,139 claimed identical claims as the instant claims 1-10, 15-16, and 19-21.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the instant claims and the prior art claims is that the instant claims have alkyl substituent such as CF<sub>3</sub>, CH<sub>2</sub>CF<sub>3</sub>, etc. for R<sup>F1</sup> and R<sup>F2</sup> instead of the alkyl in the prior art.

Finding of prima facie obviousness-rational and motivation (MPEP §2142.2143)

The instant claims 1-10, 15-16, and 19-21 are therefore fully embraced by the prior art claims.

This is provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**12.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Niloofar Rahmani whose telephone number is 571-272-4329. The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00 pm.

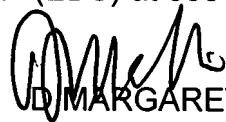
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NILOOFAR RAHMANI

09/17/2007

Nh



MARGARET SEAMAN

PRIMARY EXAMINER

GROUP 1625